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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,787	07/18/2007	Masahiro Yoshioka	063086	4744

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EXAMINER	
FINEMAN, LEE A	

ART UNIT	PAPER NUMBER
2872	

MAIL DATE	DELIVERY MODE
12/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,787	YOSHIOKA ET AL.	
	Examiner	Art Unit	
	LEE FINEMAN	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/22/06,11/28/06,2/21/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 21 February 2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The Korean office action dated 3 December 2007 is not accompanied by any English translation and does not included any identifiable search report indications or charts. Therefore the information referred to therein has not been considered and has been lined through.

Specification

2. The abstract of the disclosure is objected to because of legal phraseology (i.e. comprises). Correction is required. See MPEP § 608.01(b).

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

4. Claim 3 is objected to because of the following informalities:

Claim 3 includes the limitation "wherein the birefringent material shows liquid crystalline…" It is unclear what is meant by "shows." Is it that the birefringent material is a

liquid crystalline or does it demonstrate liquid crystalline properties? For the purposes of examination, it will be taken to mean that the birefringent material is a liquid crystalline.

Appropriate correction is required.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 19-35 of copending Application No. 11/661362. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-9 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamijo et al., US 7,289,266 B1 (henceforth Kamijo).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Kamijo discloses a polarizing plate (column 11, lines 54-56) comprising: a polarizer (fig. 1) and a protective film laminated on one or both sides of the polarizer with an adhesive layer (column 12, line 59-column 13, line 3), wherein the polarizer comprises a monolayer film (fig. 1) having a structure having a minute domain (3) dispersed in a matrix formed of an optically-transparent water-soluble resin (1) including an iodine based light absorbing material (2), and the adhesive layer is made of an adhesive that contains a resin curable with an active energy beam or an active material (column 13, line 2).

Regarding claims 2 and 3, Kamijo further discloses wherein the minute domain of the polarizer is formed of an oriented birefringent material and wherein the birefringent material shows liquid crystalline at least in orientation processing step (column 6, lines 17-23).

Regarding claim 4, Kamijo further discloses wherein the minute domain of the polarizer has 0.02 or more of birefringence (column 2, lines 57-58).

Regarding claim 5, Kamijo further discloses wherein in a refractive index difference between the birefringent material forming the minute domain and the optically-transparent

water-soluble resin of the polarizer in each optical axis direction, a refractive index difference (Δn^1) in direction of axis showing a maximum is 0.03 or more, and a refractive index difference (Δn^2) between the Δn^1 direction and a direction of axes of two directions perpendicular to the Δn^1 direction is 50% or less of the Δn^1 (column 2, lines 63-column 4, line 3).

Regarding claim 6, Kamijo further discloses wherein an absorption axis of the iodine based light absorbing material of the polarizer is oriented in the Δn^1 direction (column 3, lines 24-26).

Regarding claim 7, Kamijo further discloses wherein the film used as the polarizer is manufactured by stretching (column 3, lines 66-67).

Regarding claim 8, Kamijo further discloses wherein the minute domain of the polarizer has a length of 0.05 to 500 μm in the Δn^2 direction (column 4, lines 6-7).

Regarding claim 9, Kamijo further discloses 9wherein an iodine based light absorbing material of the polarizer has an absorbing band at least in a band of 400 to 700 nm wavelength range (column 4, lines 16-18).

Regarding claim 14, Kamijo further discloses wherein a transmittance to a linearly polarized light in a transmission direction is 80% or more, a haze value is 5% or less, and a haze value to a linearly polarized light in an absorption direction is 30% or more (column 4, lines 34-67).

Regarding claim 15-17, Kamijo further discloses wherein the polarizer as set forth above is an optical film and image display (column 13, lines 60-65).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being obvious over Kamijo.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claims 12 and 13, Kamijo further discloses wherein the protective film has a thickness direction retardation Rth = {(nx + ny) / 2 - nz} x d is 30 nm or less, where a direction of a transparent protective film in which an in-plane refractive index within the film surface

concerned gives a maximum is defined as X-axis, a direction perpendicular to X-axis is defined as Y-axis, a thickness direction of the film is defined as Z-axis, refractive indices in axial direction are defined as nx, ny, and nz, respectively, and a thickness of the film is defined as d (nm) (column 12, lines 44-58) and wherein the protective film comprises at least one selected from a resin composition containing a thermoplastic resin (A) having a substituted and/or non-substituted imide group in a side chain and a thermoplastic resin (B) having substituted and/or non-substituted phenyl group and nitrile group in a side chain (column 12, lines 20-31). Kamijo discloses the claimed invention except for explicitly stating wherein the protective film has an in-plane retardation Re = (nx - ny) x d is 20 nm or less. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made (nx - ny) x d is 20 nm or less, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering an optimum value or working ranges involves only routine skill in the art. One would have been motivated to have (nx - ny) x d is 20 nm or less for the purpose of providing specific light directing characteristics. *In re Aller*, 220 F.2d 454, 456 105 USPQ 233, 235.

11. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being obvious over Kamijo in view of Nakahara et al., JP 2002-148436 (henceforth Nakahara).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claims 10 and 11, Kamijo discloses the claimed invention except for wherein the adhesive is an active energy beam-curable solventless adhesive or a moisture-curable one-component adhesive and wherein the protective film has a bonded surface that has been subjected to at least one treatment selected from corona treatment, plasma treatment, flame treatment, primer coating treatment, and saponification treatment. Nakahara teaches a moisture-curable one-component adhesive to provide adhesion between a polarizer and a the protective film which has a bonded surface that has been subjected to at least one treatment selected from corona treatment, plasma treatment, flame treatment, primer coating treatment (abstract). It would have been obvious to one of ordinary skill in the art to replace the adhesive of Kamijo with that of Nakahara to provide excellent adhesion and resistance to moist heat (see Nakahara English translation section [0013]).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ito et al., US 2003/0137633 A1 and Taguchi et al., US 2002/0084447 A1 disclose polarizing plates with a polarizer having minute domains.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE FINEMAN whose telephone number is (571)272-2313. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lee Fineman/
Primary Examiner, Art Unit 2872
11 December 2008